

REMARKS

Claims 1-31 are pending in the application.

Claims 1-31 have been rejected.

Claims 1, 16, 27 and 30 have been amended, as set forth herein.

I. REJECTION UNDER 35 U.S.C. § 103

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Han, et al. (US 5,818,903 (hereinafter "Han")) in view of Alajajian (US 5,668,880). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to Han, Applicant respectfully submits that though Han apparently recites that a message is transmitted from a mobile station (in an abstract sense and not in the context of the subject matter of Applicant's invention), there is, however, no disclosure reciting the receiving of the message, or reciting the message was "composed" by a calling party - as arranged as they are in the Applicant's claims. Moreover, Han is a simulation device. The Han simulation device is directed to a CDMA mobile automatic call simulating method and a simulator therefor which overcomes the problems encountered in the conventional CDMA mobile automatic call simulating method and a simulator therefore. Thus, Han is directed to

a distinctly different invention in a different area (simulator and simulating methods) and not directed, or related, to receiving messages from a calling party (and sending to a called party at a determined communication address) when a synchronous call attempt is unsuccessful.

With respect to Alajajian, Applicant respectfully submits that though Alajajian apparently recites, in general terms, an element that may be construed as receiving a message composed by the calling party, Alajajian's receiving of messages is not related to an unsuccessful synchronous call attempt. Alajajian is directed to a wireless inter-vehicle personal communication devices and local area network. See, Abstract, Col. 6, lines 30-43. Thus, Alajajian describes successful communications (connections or calls) between two inter-vehicle devices but fails to address responses or actions taken when the communications (connections or calls) are unsuccessful. Accordingly, Applicant respectfully submits that there is no motivation to combine Han or Alajajian, and therefore, none of the references, taken alone or in combination, disclose, teach or suggest Applicant's claimed invention.

With respect to independent Claims 1, 16 and 30, Applicant has amended the claims (solely to clarify and more distinctly point out Applicant's invention) to recite that the message composed by the calling party is received after the synchronous call attempt to the called party is dropped. Neither reference discloses, teaches or suggests these element/feature, as recited in the independent Claims 1, 16 and 30 (and dependent claims).

With respect to independent Claim 27, Applicant has amended the claim (solely to clarify and more distinctly point out Applicant's invention) to recite that an indication (that the

calling party wishes to send a message) from the calling party is detected during the synchronous call attempt. Neither reference discloses, teaches or suggests these element/feature, as recited in independent Claim 27 (and dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-31.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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